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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 08/738,659

Filing Date: 10/30/96

Appellant(s): Motoyama

James J. Kulbaski

For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 02/17/1999.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims of the following groups of claims stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Group I: Claims 10, 14-17, 36, 40-43, and 52-61.

Group II: Claims 12 and 38.

Group III: Claims 13, 19, and 39.

Group IV: Claims 18 and 44.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix A to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Kraslavsky et al	5,537,626	07-1996
Cohn et al	5,740,231	04-1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 10, 12-19, 36, 38-44, and 52-61 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Kraslavsky et al (Kraslavsky)** patent no. **5,537,626**, in view of **Cohn et al (Cohn)** patent no. **5,740,231**.

2. As to claim 10, Kraslavsky teaches the invention substantially as claimed, including a method for communicating between a monitored device and a monitoring device (printer 4 and NTWK ADMIN PC 14, figure 1) comprising the steps of:

determining information to be transmitted by the monitoring device to the monitored device, the information including a request for a status of the monitored device determined using sensors within the monitored device (col. 39 lines 9-20, and Table 10 begins on col. 41 line 35, Kraslavsky inherently teaches the information of the printer is obtained from sensors as clearly described by Banno et al patent no. 4,876,606 dated 10/24/89 col. 3 line 66 - col. 4 line 11); and

transmitting the information as an message from the monitoring device to the monitored device through a Wide Area Network (col. 7 lines 38-63).

However, Kraslavsky does not explicitly teach the message is an Internet electronic mail message.

Cohn teaches various source and destination message systems that comprise voice mail, electronic mail, facsimile transmission, video transmission facilities, other data transmission or receipt facilities that can communicate message to each others using Internet electronic mail message format (col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Kraslavsky and Cohn to use Internet electronic mail message to communicate between Kraslavsky's monitored and monitoring devices because it would allow message to be transferred globally between any devices.

3. As to claims 12-13, Kraslavsky teaches transmitting a message to the monitored device which is a business office device such as copier, facsimile machine, or printer (Abstract, and col. 2 lines 35-62).

4. As to claim 14, Kraslavsky and Cohn teach receiving the transmitted information by the monitored device; and transmitting an Internet electronic mail message from the monitored device to the monitoring device containing status information of the monitored device, in response to the transmitted information from the monitoring device (Kraslavsky, col. 2 lines 35-62; Cohn, col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36).

5. As to claim 15, Kraslavsky teaches transmitting the information from the monitoring device to a plurality of monitored devices including the monitored device (col. 34 lines 63-67).

6. As to claim 16, Kraslavsky teaches the invention substantially as claimed, including a method for communicating between a machine and a monitoring device, comprising the steps of:
determining status information using at least one of a mechanical and electrical sensor (col.

39 lines 9-20, and Table 10 begins on col. 41 line 35, Kraslavsky inherently teaches the information of the printer is obtained from sensors as clearly described by Banno et al patent no. 4,876,606 dated 10/24/89 col. 3 line 66 - col. 4 line 11); and

transmitting the status information from the machine to the monitoring device through a Wide Area Network (col. 7 lines 38-63).

However, Kraslavsky does not explicitly teach the message is an Internet electronic mail message.

Cohn teaches various source and destination message systems that comprise voice mail, electronic mail, facsimile transmission, video transmission facilities, other data transmission or receipt facilities that can communicate message to each others using Internet electronic mail message format (col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Kraslavsky and Cohn to use Internet electronic mail message to communicate between Kraslavsky's machine and monitoring device because it would allow message to be transferred globally between any machine and device.

7. As to claim 17, Kraslavsky and Cohn teach analyzing the status information by the machine, wherein the status information is transmitted as the Internet electronic mail message from the machine when the status information is analyzed and determined to be within a standard operating range (Kraslavsky, col. 39 lines 20-54; Cohn, col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36).

8. As to claim 18, Kraslavsky and Cohn teach determining status information which is outside of normal operating parameters exists in the machine using at least one of the mechanical and electrical sensor; and transmitting a connection-mode message from the machine to the monitoring device containing the status information which is outside of the normal operating parameters (Kraslavsky, col. 39 lines 20-54; Cohn, col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36, Kraslavsky inherently teaches the information of the printer is obtained from sensors as clearly described by Banno et al patent no. 4,876,606 dated 10/24/89 col. 3 line 66 - col. 4 line 11).

9. As to claims 52-53, Cohn inherently teaches Internet electronic mail message includes an "@" symbol followed by a domain name, and a description of an encoding type of the Internet electronic mail message. This information is also admitted by applicant as well known.

10. As to claim 54, Kraslavsky and Cohn teach the invention substantially as claimed as discussed above; however, they do not explicitly teach using a firewall. Official Notice is taken that firewall is well known in Data Processing Art. It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to use a firewall in Kraslavsky and Cohn's network because it would not allow communication between the monitor device and the machine if message do not satisfy filter conditions in the firewall.

11. Claims 19, 36, 38-44, and 55-61 have similar limitations as claims 10, 12-18 and 52-54;

therefore, they are rejected under the same rationale.

(11) Response to Argument

(A) Applicant argues with respect to group I that one of ordinary skill in the art would not have any motivation to modify the primary reference of Kraslavsky to operate using Internet electronic mail as disclosed in the secondary reference to Cohn, and applicant provides various rationales to show Kraslavsky and Cohn might not be combined together.

As to point (A), Kraslavsky teaches the invention substantially as claimed, including a method for communicating between a monitored device and a monitoring device (printer 4 and NTWK ADMIN PC 14, figure 1) comprising the steps of:

determining information to be transmitted by the monitoring device to the monitored device, the information including a request for a status of the monitored device determined using sensors within the monitored device (col. 39 lines 9-20, and Table 10 begins on col. 41 line 35, Kraslavsky inherently teaches the information of the printer is obtained from sensors as clearly described by Banno et al patent no. 4,876,606 dated 10/24/89 col. 3 line 66 - col. 4 line 11); and

transmitting the information as an message from the monitoring device to the monitored device through a Wide Area Network (col. 7 lines 38-63).

However, Kraslavsky does not explicitly teach the message is an Internet electronic mail message.

Cohn teaches various source and destination message systems that comprise voice mail, electronic mail, facsimile transmission, video transmission facilities, other data transmission or

receipt facilities that can communicate message to each others using Internet electronic mail message format (col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Kraslavsky and Cohn to use Internet electronic mail message to communicate between Kraslavsky's monitored and monitoring devices because it would allow message to be transferred globally between any devices.

The test for obviousness is not whether the features of one reference may be bodily incorporated into the other reference to produce the claimed subject matter but simply what the references make obvious to one of ordinary skill in the art.

"(T)he proper inquiry should not be limited to the specific structure shown by the references, but should be into the concepts fairly contained therein, and the overriding question to be determined is whether those concepts would suggest one skilled in the art the modification called for by the claims", In re Bascom, 109 USPQ 98, 100 (CCPA 1956). "What appellants overlook is that it is not necessary that the inventions of the references be physically combinable to render obvious the invention under review." In re Sneed, 218 USPQ 385, 389 (CAFC 1983). "The argument that one cannot bodily incorporate the two set of references because in one the speed of the air-fuel mixture is allegedly subsonic, whereas in the other it is sonic, is irrelevant. The test for obviousness is not whether the features of one reference may be bodily incorporated into another reference. Rather, we look to see whether the combined teachings render the claimed subject matter obvious", In re Wood and Eversole, 202 USPQ, 171, 174 (CCPA, 1979).

(B) and (C) Applicant argues with respect to groups II and III that the prior art of record does not teach the use of Internet e-mail in a business office device being one of a copier, a facsimile machine, and a printer.

As to points (B) and (C), Kraslavsky and Cohn in combination teaches using Internet e-

mail message in monitoring device and monitored device (business office device) as discussed in point (A). In addition, Kraslavsky teaches the monitored device is a local area network peripheral such as a printer (Abstract, col. 2 lines 35-62, and printer 4 in figure 1), and Cohn teach the monitored device is a facsimile machine, voice mail, electronic mail, video transmission facilities, other data transmission or receipt facilities (col. 8 lines 36-65).

(D) Applicant argues with respect to groups IV that the prior art of record does not teach using a connection mode message when the status information is outside of the normal operating parameters. In addition, applicant argues that Examiner has found similar limitations to be patentable in parent application, now U.S. patent no. 5,819,110.

As to point (D), Kraslavsky teaches using connection mode message when the status information is outside of the normal operating parameters such as OFFLINE, LINEERROR22, etc. (col. 39 lines 20-54). Moreover, applicant is **totally incorrect** when asserted that the limitations "using a connection mode message when the status information is outside of the normal operating parameters" was the reason for allowance for U.S. patent no. 5,819,110.

In U.S. patent no. 5,819,110, all independent claims have similar limitations as independent claim 1 as shown below, and the record shows that the independent claims were allowed because of the limitations which are highlighted and underlined as shown below combined with other limitations in the claim.

1. A method for communicating between a monitored device and a monitoring device,

comprising the steps of:

determining information to be transmitted between the monitored device and the monitoring device;

determining whether a mode of communication to be used between the monitored and the monitoring device is a connection-mode or a connectionless-mode of communication by analyzing a content of the information to be transmitted;

transmitting the information by the connection-mode of communication between the monitored device and the monitoring device, when the step of determining the mode of communication has determined that the connection-mode of communication is to be used; and

transmitting the information by the connectionless-mode of communication between the monitored device and the monitoring device, when the step of determining the mode of communication has determined that the connectionless-mode of communication is to be used, wherein:

the step of determining the mode of communication to be used comprises determining whether the mode of communication to be used is the connection-mode or the connectionless-mode of communication by analyzing the content of the information to be transmitted which is based on an event which occurred in the monitored device and was monitored by sensors within the monitored device,

the sensors in the monitored device sense events having a first priority and events having a second priority which is lower than the first priority, the step of determining the mode of communication to be used comprises determining the connection-mode of

Serial Number: 08/738,659
Art Unit: 2756

12

communication is to be used when the first priority event is sensed and determining the connectionless-mode of communication is to be used when the second priority event is sensed, the sensing of the first priority event comprises sensing a problem in the monitored device, and

the sensing of the second priority event comprises sensing usual conditions in the monitored device which are transmitted in a regularly generated report.

For the reasons above, it is believed that the rejections should be sustained.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Le Hien Luu', with a long horizontal flourish extending to the right.

Le Hien Luu

March 31, 1999